

REMARKS

The Office Action dated 07/12/04 has been fully considered by the Applicant. Claims 1 and 16 have been currently amended. Claims 2-15 and 18-21 have been previously presented. Claim 17 has been canceled.

Enclosed is Petition to Request A Three-Month Extension of Time and a check for \$1020 to cover the cost of the Extension.

Examiner Krishnamurthy has indicated that claims 15, 18 and 20 are allowed.

Claims 9 and 16 have been objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form. Applicant acknowledges the Examiner's objection of these claims.

Claims 1-8 and 10-14 have been rejected under 35 USC 103(a) as being unpatentable over the prior art admitted to by Applicant Figures 1-4 in view of the document "Automatischer Duerchflussregler", Technische Rundschau, Vol 62, No. 44, 10/16/70, page 29 (herein referred to as D1). Reconsideration of the rejection is respectfully requested.

Claim 1 has been amended to further define that the control pressure is a gas pressure.

Several features of cited reference D1, if taken in its entirety, would make it inappropriate for use as a pilot valve for controlling mains water PRVs, as in Applicant's invention. For instance, the spring in D1 document is not separated from the fluid by a diaphragm, and the control pressure is the input pressure of the fluid to be controlled. Examiner Krishnamurthy has indicated that a skilled worker would know from the pilot valves shown in Prior Art Figures 2 to 4 of Applicant's invention that a second diaphragm should be used. In other words, Examiner Krishnamurthy argues that a skilled worker would select only the second chamber diaphragm feature from document D1

when modifying the pilot valves of Prior Art Figures 2 to 4 of Applicant's application and that same skilled person would then simply ignore the rest of the document D1 design. Applicant believes that it would not have been obvious to one skilled in the art to combine the pilot valve of Prior Art Figures 2 to 4 of the present application with selected features of documents D1 and D2 .

It is improper to combine references to achieve the invention under consideration unless there is some incentive or suggestion in the references to do so.

The Court of Appeals for the Federal Circuit has repeatedly held that under Section 103, teachings from various references can be combined only if there is some suggestion or incentive to do so. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F2d 1572, 221 USPQ 929 (CAFC 1984).

Stated another way:

It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps...The references themselves must provide some teaching whereby the applicant's combination would have been obvious. In re Gorman, 18 USPQ2d 1885 (CAFC 1991).

In the present invention, there is no suggestion in the references to combine the teachings of document D1 (Automatischer Durchflussregler), and the Prior Art Figures 1-4 as presented in Applicant's invention. The Examiner is required to follow the law as set forth by the Federal Circuit. In summary, the combination of patents to achieve the claims of the present invention is untenable. Therefore, reconsideration of the rejection is requested.

Claims 17, 19, and 21 have been rejected under 35 USC 103(a) as being unpatentable over the combination of prior art admitted to by the Applicant in Figures 1-4 in view of the document D1

as applied to claims 1-8 and 10-14 above and further in view of United States Patent No. 5,460,196 to Yonnet, who is also the current Applicant. Reconsideration of the rejection is requested.

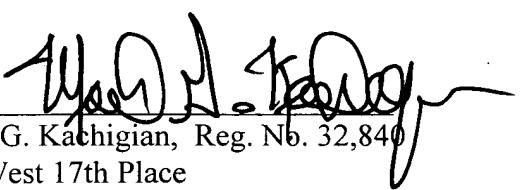
Claim 17 depends on currently amended claim 1. Applicant believes that currently amended claim 1 is novel over the cited art as stated above herein and believes that therefore claim 17 is also novel because it depends upon an allowable independent claim.

It is believed that the application is now in condition for allowance and such action is earnestly solicited. If any further issues remain, a telephone conference with the Examiner is requested. If any additional fees are associated with this response, please charge Deposit Account No. 08-1500.

Respectfully Submitted

HEAD, JOHNSON & KACHIGIAN

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BY: 
Mark G. Kachigian, Reg. No. 32,840
228 West 17th Place
Tulsa, Oklahoma 74119
(918) 584-4187
Attorneys for Applicant